

REMARKS

This communication is a full and timely response to the non-final Office Action dated August 9, 2004 (Paper No./Mail Date 20040803). By this communication, claims 3, 5, and 8 have been canceled without prejudice and claims 1 and 7 have been amended.

Claim 1 has been amended to incorporate the subject matter of canceled claims 3, 5, and 8. Support for the subject matter added to claim 1 can be found variously throughout the specification and claims, for example, in original claims 3, 5, and 8. No new matter has been added.

Claim 7 has been amended to address formal matters. No new matter has been added.

Claims 1, 2, 4, and 7 are pending where claim 1 is independent.

Rejections Under 35 U.S.C. §103

Claims 1-8 were rejected under 35 U.S.C. §103(a) as obvious over *Scroggie et al.*, U.S. Patent No. 6,014,634. Applicant respectfully traverses this rejection.

Claim 1 recites a presentation method for providing advertisement information stored in a server to an exhibitor via a network comprising the steps of requesting access to information stored in the server over the network; selecting advertisement information among information stored in the server when access is authorized; sending selected advertisement information from the server to the exhibitor over the network, wherein the selected advertisement information is a questionnaire, and a response to the questionnaire is communicated over the network from the audience to the server, and wherein the advertisement information sent to the exhibitor is transmitted to a movie theater and shown to the audience before or after a feature presentation as a digital motion picture projected from a movie projector.

The present invention includes bidirectional communications to a large number of clients. A digital image projected from a projector apparatus includes advertisement information that is presented to the large number of clients in a movie format. The present invention receives opinions from a large number of clients by questioning the audience in a movie theater either before or after the feature presentation.

Scroggie discloses a system and method for providing shopping aids and incentives to customers through a computer network. In this system, a communication network connects consumers 10, retailers 12, and manufacturers 14. The consumers 10 log-in to the network and navigate to an offer browser 22. The offer browser 22 receives offer data from manufacturers 14

on a periodic basis, and displays the offers to consumers 10 who have logged in. The consumers 10 may select any offer provided on the offer browser 22 by the manufacturers 14. The selected offers are accumulated in a session record maintained for the duration the consumer 10 is logged-in to the system.

Scroggie fails to disclose, teach, or suggest at least the advertisement information sent to the exhibitor is transmitted to a movie theater and shown to the audience before or after a feature presentation as a digital motion picture projected from a movie projector. In contrast, *Scroggie* discloses a system in which information is communicated to and from a user on a personal computer. Moreover, the system of *Scroggie* is used to promote consumer purchases, and does not improve the vision of the advertisement information. Still further, *Scroggie* carries out a questionnaire survey along with evaluating purchase activity to improve the marketing of incentives to consumers. Thus, a *prima facie* case for obviousness has not been established.

The Office Action acknowledged that *Scroggie* fails to disclose, teach, or suggest the elements recited in claims 2-8, and relied on the taking of *Official Notice* to remedy this deficiency. Because Applicant has amended claim 1 to include the subject matter of canceled claims 3, 5, and 8 the taking of *Official Notice* now applies to claim 1.

In a memo to the Examining Corps and Technology Center Directors, Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, stated that reliance on "Official Notice" when an application is under final rejection should be rare. See "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice," United States Patent and Trademark Office, memo from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, page 2 (February 2002). Moreover, Mr. Kunin stated, "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." See *Id.* "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." See *Id.*

In addition, if the Examiner believes that claim 1 still read on a prior art reference, Applicant hereby requests that the Examiner either:

- (a) Provide another non-final Office Action withdrawing Official Notice, and applying a suitable reference for the asserted rejection;
or
- (b) Issue another rejection under an appropriate statutory provision and provide an affidavit or suitable reference attesting to all the elements taken as Official Notice.

By this reply, Applicant has timely challenged the Examiner's Official Notice. Further, Applicant respectfully submits that a *prima facie* case for obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the reasons above, Applicant respectfully requests that the rejection of claim 1 under §103 be withdrawn and this claim be allowed.

Claims 2, 4, and 7 depend from claim 1. By virtue of this dependency, Applicant submits that claims 2, 4, and 7 are allowable for at least the same reasons given above with respect to claim 1. In addition, Applicant submits that claims 2, 4, and 9 are further distinguished over *Piestrup* and *Lam* by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully requests, therefore, that the rejection of claims 2, 4, and 9 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants submit that claims 1, 2, 4, and 9 are allowable, and this application is in condition for allowance. Accordingly, Applicants request favorable reexamination and reconsideration of the application. In the event the Examiner has any comments or suggestions for placing the application in even better form, Applicants request that the Examiner contact the undersigned attorney at the number listed below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. UDK-001 from which the undersigned is authorized to draw.

Dated: *October 29, 2004*

Respectfully submitted,

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